

**REMARKS**

In the Office Action, the Examiner indicated that claims 1 through 23 are pending in the application, and that claims 1-11 and 13-23 are rejected and claim 12 is withdrawn.

**The Issuance of the Final Rejection was Premature**

In the Office Action, the Examiner issued a final rejection, asserting that the amendments submitted necessitated the new grounds of rejection. This assertion is respectfully traversed. Applicant submitted the amendments in response to a restriction requirement. In the Office Action in which the Examiner issued the restriction requirement, the Examiner also pointed out § 112 issues in the claims. In responding to the restriction requirement, applicant also amended certain of the claims to place them within one of the restriction species. Since the Examiner had not previously performed a substantive examination of the claims, the amendments made in response to the restriction requirement could not have necessitated a new search.

In the present Action, the applicant is still seeking to define the invention in the claims to obtain a reasonable level of claim coverage. In this regard, the Examiner has been extremely helpful in assisting in arriving at claim language that appropriately recites the invention. However, the issuance of a final Office Action is premature in this case. As set forth in the M.P.E.P.:

“the applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the Examiner to that end, and not be prematurely cut off from the prosecution of his or her application.”

*M.P.E.P. §706.07.*

In the present case, the most recent Office Action represents the first time the Examiner has substantively rejected the claims based upon art. In the interest of fairness, the applicant should be given the opportunity to amend the claims, or present arguments against the application of the cited art, while not under a final rejection. Accordingly, the applicant respectfully requests the Examiner to reconsider and withdraw the finality of the present Office Action.

**Claim Rejections, 35 U.S.C. §112**

At item 1 of the Office Action, the Examiner rejected claims 1-11 and 13-23 under 35 U.S.C. §112, second paragraph.

With respect to the §112 rejection of claims 1 and 13, applicant respectfully traverses this rejection. The Examiner asserts that the verification-related digital certificate information is “printed on the EPI”. This is incorrect. Nowhere in the claims is there any requirements or assertion that the verification-related digital certificate information is printed on the EPI.

Applicant notes, however, that in dependent claim 2 and dependent claim 14, an electronically-readable indicia that corresponds to the verification-related digital certificate information is associated with the EPI. This association could be, but is not required to be, made by physical attachment of the indicia to the EPI. This is consistent with the specification

and is also consistent with the claims. There are indeed two different recited pieces of information. One is “verification-related digital certificate information” and the other is “an *electronically-the readable indicia* containing electronically-readable information corresponding to said verification-related digital certificate information”.

Applicant has also amended claim 23 so that it now properly depends from claim 14.

In view of the above comments and the amendments made in the present response, it is respectfully submitted that the claims meet the requirements of 35 U.S.C. § 112. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-11 and 13-23 under 35 U.S.C. § 112.

### **The §103 Rejections**

On page 3 of the Office Action, the Examiner rejected claims 1-11 and 13-23 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,223,166 to Kay (“Kay”).

At the time the present invention was made, Kay was assigned to International Business Machines Corporation, as is the present invention. Accordingly, Kay is not prior art for the purposes of a rejection under 35 U.S.C. §103, pursuant to 35 U.S.C. §103(c). Thus, it is submitted that the rejection of the claims under 35 U.S.C. §103, which specifically cite the Kay patent as prior art, are improper. Accordingly, the Examiner is requested to reconsider and withdraw the rejection of claims 1-11 and 13-23 under 35 U.S.C. §103.


**Conclusion**

The Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No.09-0461.

Respectfully submitted

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Date

  
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